

REMARKS-General

1. The previously presented claims 3 to 8 are amended and the newly drafted independent claim 13 incorporates all structural limitations of the original claim 1 and includes further limitations previously brought forth in the disclosure. No new matter has been included. The amended claims 3 to 8 and the new claims 13 to 17 are submitted to be of sufficient clarity and detail to enable a person of average skill in the art to make and use the instant invention, so as to be pursuant to 35 USC 112.

Response to Rejection of Claims 1 to 8 under 35USC103

2. The Examiner rejected claims 1 to 8 over Kralik in view of Ou. Pursuant to 35 U.S.C. 103:

"(a) A patent may not be obtained though the invention is **not identically** disclosed or described as set forth in **section 102 of this title**, if the **differences** between the subject matter sought to be patented and the prior art are such that the **subject matter as a whole would have been obvious** at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

In view of 35 U.S.C. 103(a), it is apparent that to be qualified as a prior art under 35USC103(a), the prior art must be cited under 35USC102(a)~(g) but the disclosure of the prior art and the invention are not identical and there are one or more differences between the subject matter sought to be patented and the prior art. In addition, such differences between the subject matter sought to be patented **as a whole** and the prior art are obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

3. In other words, the differences between the subject matter sought to be patent as a whole of the instant invention and Kralik which is qualified as prior art of the instant invention under 35USC102(b) are obvious in view of Ou at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains.

4. The applicant respectfully submits that to reject claims in a patent application under 35 U.S.C. 103, the Examiner must show an un rebutted prima facie case of

obviousness. See *In re Deuel*, 51 F.3d 1552, 1557, 34 USPQ2d 1210, 1214 (Fed. Cir. 1995).

A prima facie case of obviousness requires setting forth:

- (1) the differences in the claim over the applied references,
- (2) the proposed modification of the applied references necessary to arrive at the claimed subject matter, and
- (3) an explanation why such proposed modification would be obvious. MPEP §706.02.

5. The applicant respectfully submits that Kralik merely suggests an inflatable padded game ball comprising a bladder, an outer carcass, padding and a liner assembly, wherein:

(i) the padding covers substantially the entire inner surface of the carcass and can be adhered thereto or to the liner assembly (column 2, lines 46-48); and

(ii) the liner assembly is also of multi-layer construction, including an outer reinforcement layer made of woven fabric, preferably polyester, **a control layer of sheet material, preferably ethylene vinyl acetate**, and an inner reinforcement layer of the same material as outer layer, wherein the outer and inner woven reinforcement layers, respectively, are embedded in the middle layer that is done immediately after extrusion of the middle layer before it has set, by **embedding the inner and outer layers in it through the use of rollers or the like** (column 3, lines 12-24).

6. Therefore, Kralik fails to suggest the following structural features of claims 3-8 and 13-17 of the instant invention:

(a) Each of the claims 3 to 8 merely claims a construction liner comprising an integral liner piece which is compressed and vulcanized from at least a rubber piece and at least a fabric lining while Kralik just teaches an American football having a liner assembly adhered to the padding of the carcass, wherein the liner assembly includes two fabrics just embedded with a control layer therebetween by rollers. It is totally

different to an integral liner piece which integrally united at least a rubber piece with at least a fabric lining by compression and vulcanization.

(b) In claims 5 and 6, the integral liner piece of the construction liner of the instant invention is claimed to be integrally united from one rubber piece sandwiched between two fabric linings by compression and vulcanization.

(c) In claim 7, the integral liner piece of the construction liner of the instant invention is claimed to be integrally united from two rubber pieces and two fabric linings integrally by compression and vulcanization.

(d) In claim 8, the integral liner piece of the construction liner of the instant invention is claimed to be integrally united from two rubber pieces and three fabric linings integrally by compression and vulcanization.

(e) Claims 13 to 17 claim an American football constructed with a construction liner having the distinctive structural features (a) to (d) as claimed in the above claims 3-8 respectively.

7. The Examiner appears to reason that since Ou reveals an American football including a panel formed from rubber and fabric lining which are vulcanized together to **form the panel**, it would have been obvious to one skilled in the art to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet in order to take advantage of rubber's well known physical characteristics.

8. But this is clearly **not** a proper basis for combining references in making out an obviousness rejection of the present claims. Rather, the invention must be considered as a whole and there must be something in the reference that suggests the combination or the modification. See Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984) ("The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination"), In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), ("The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.") In re Laskowski, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989), ("Although the Commissioner suggests that

[the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.")

9. In the present case, there is no such suggestion. The '123 patent, Ou, is an earlier patent issued to the inventor of the instant invention. According to the rejection reason, the claims 1-8 seem to be rejected under 35USC103(a) over Ou in view of Kralik. No matter Ou in view of Kralik or Kralik in view of Ou, both Kralik and Ou perform very different types of invention, wherein neither Kralik nor Ou suggests any construction liner which is an integral liner piece but not merely embedded layers together by rollers as taught by Kralik while the applicant's '123 patent merely suggests a sewing rubber American football by teaching how to use rubber as carcass material instead of leather or synthetic leather as usual.

10. In any case, even combining Kralik and Ou would not provide the invention as claimed -- a clear indicia of nonobviousness. Ex parte Schwartz, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992), ("Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed.").

11. Although the Examiner provides an explanation that to replace the ethylene vinyl acetate sheet of Kralik with a rubber sheet of Ou is an obvious modification at the time of the invention. However, Kralik does not suggest how to integrally unite rubber piece with fabric lining to form an integral liner piece while Ou merely suggests how to use rubber as a material of carcass of American football and contains no construction liner. In fact, Ou does not suggest any of the different subject matters (a) to (d) as stated above between the instant invention and Kralik, that is, modifying Kralik with Ou, as proposed by the Examiner, it would not suggest any construction liner which is an integral liner piece made by compression and vulcanization of one or more rubber pieces and one or more fabric linings as claimed in claims 3-8 and 13-17 of the instant invention. In fact,

12. Applicant believes that neither Kralik nor Ou, separately or in combination, suggest or make any mention whatsoever of construction liners as recited in claims 3-8 and 13-17.

13. **Commercial Success:** Attached hereto is a Rule 132 Declaration by the inventor, Tsung Ming Ou, of the present application.

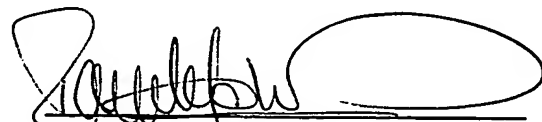
The inventor currently makes and sells American football embodying the subject matter of the instant invention's claims 3-8 and 13-17. This American football is sold under the trademarks "WILSON", "SPALDING" and "RAWLINGS" and was introduced commercially in approximately the year of 1999. For the entire year of 2002 and 2003, more than 1,560,000 pieces and 1,520,000 pieces of American football were sold.

The applicant believes that, an important reason for the commercial success of the instant invention is its superior structural characteristics, which has been expressed in claims 3-8 and 13-17 of the instant invention.

14. The Rule 132 Declaration sets forth in detail evidence of the commercial success of the instant invention, which is an American football embodying claims 3-8 and 13-17 made and sold by the applicant of the instant invention. Based on this evidence, which both rebuts the *prima facie* of obviousness and establishes an important secondary factor of non-obviousness, namely commercial success, the Examiner is requested to reconsider and withdraw the obviousness rejection made against the instant invention.

15. In view of the above, it is submitted that the claims are in condition for allowance. Reconsideration and withdrawal of the rejection are requested. Allowance of claims 3-8 and 13-17 at an early date is solicited.

Respectfully submitted,



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App. Nr.: 10/092,578 (Ou)

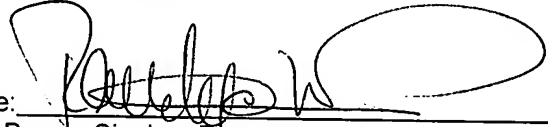
Amendment D (contd)

Certification of Mailing

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I certify that this correspondence will be deposited with the United States Postal Service as Express mail with proper postage affixed in an envelope addressed to: "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" on the date below.

Date: June 17, 2004

Signature: 
Name of Person Signing: Raymond Y. Chan